



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,545	02/23/2004	Kevin George	50T5443.01	7768
42717	7590	10/16/2008		
HAYNES AND BOONE, LLP			EXAMINER	
901 Main Street			NGUYEN, THUY-VI THI	
Suite 3100				
Dallas, TX 75202			ART UNIT	PAPER NUMBER
			3689	
			MAIL DATE	DELIVERY MODE
			10/16/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/784,545

**Applicant(s)**

GEORGE ET AL.

**Examiner**

THUY VI NGUYEN

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-24 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-24, 27-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This is response to the applicant's communication filed on 07/14/08, wherein:

Claims 5-6, 25-26 have been cancelled.

Claims 1 and 21 have been amended;

Claims 1-4, 7-24, 27-36 are currently pending;

The amended claim 1 is as follow:

1. A method for processing at least one digital image to provide a photofinishing product to a user, comprising:

receiving at least one digital image located on a physical medium provided by the user;

responsive to a user request, offering to the user at least one operator-definable package of photofinishing products;

receiving an input specifying at least one package selected by the user; and  
providing a photofinishing product to file user in accordance with the specified package,  
wherein the package of photofinishing products includes a second physical medium  
onto which the digital image is transferred.

### ***Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-20**, are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. With respect to **claims 1-20**, the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. For instance in claim 1, the process steps of *"receiving a digital image, offering the package of photofinishing products, receiving the package, and providing a photofinishing products in accordance with the specified package"* is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims **1-4, 7-24, 27-36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, step (b), recites the limitation "a user". It's not clear whether this is a new or other user or the same user as in step (a)? If this refers to a "new user", then what happens to the previous user of step (a)?

Claim 1, step (d), recites the limitation "*providing a photofinishing product to the user in accordance with the specified package, wherein the package of photofinishing products includes a second physical medium onto which the digital image is transferred*". It is unclear to the examiner either this step is done manually or electronically. Therefore, the 101 rejection is given as stated above. If the step is done electronically, then it is unclear how the package of photofinishing products is provided to the user includes a second physical medium using the digital or electronic system.

Claim 21 is a system claim, which recites the last limitation "*an operator interface operatively associated with the controller for selectively defining at least one package of photofinishing products to be offered to the user, wherein the package of photofinishing products includes a second physical medium onto which the digital image is transferred*". It is unclear how a second physical medium is included in the package of photofinishing products when this package is displayed and offer to the user by an operator interface (or a screen display).

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Parulski (US Patent No. 6,915,273).

Regarding **claim 1**, Parulski discloses a method for processing at least one digital image to provide a photofinishing product to a user, comprising:

a) receiving at least one digital image located on a physical medium provided by the user

{see col. 11, lines 62-67; col. 12, lines 1-5; figures 1A-B, 6 and 7, step (117)...  
*user uploads digital images from removable memory card (330) to the fulfillment center (40) through network channel (36)}*;

b) responsive to a user request, offering to the user at least one operator-definable package of photofinishing products

{see col. 6, lines 31-45; and figure 2, steps (106 and 110) and figures 3-4, ... *a menu of photo products for customization such as printed sizes, matte style, frame are available to customer to select...*};

c) receiving an input specifying at least one package selected by the user [...  
*user selects a menu of customizable features such as printed sizes*; col. 6, lines 39-45  
and figure 2, steps (108, 112)]; and

d) providing a photofinishing product to the user in accordance with the specified  
package

{see col. 9, lines 6-11; figure 2, steps (118-124), *photo product is delivered to the  
customer*},

wherein the package of photofinishing products includes a second physical  
medium {see figure 1B (photo product (66), custom album (62), frames (68), figure 2  
(steps 118-124), figures 3-5; col. 8, lines 8, lines 40-67, col. 9, lines 6-11, discusses  
about the delivering the package of photofinishing products includes a second physical  
such as the custom album and framed print}. As for the further (potential) feature about  
the 2<sup>nd</sup> physical medium of "*onto which the digital image is transferred*", this is not  
positively recited and is interpreted as "being capable of". The physical medium of the  
reference is capable of this feature. If applicant wants to claim the step of "transferring  
the digital image" into the 2<sup>nd</sup> physical medium, then this phrase has to be used.

Regarding **claim 2**, Parulski discloses the package of photofinishing products  
includes a photographic print of the digital image provided in predetermined quantities  
and at least one predetermined size [figures 3-4].

Regarding **claim 3**, Parulski discloses the package of photofinishing products  
includes a photographic print of the digital image provided in predetermined quantities  
for each of a plurality of predetermined sizes [figures 3-4].

Regarding **claim 4**, Parulski discloses the package of photofinishing products further includes a price for said package [figure 2, step (106)].

Regarding **claim 7**, Parulski discloses said second physical medium is a CD-ROM [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding **claim 8**, Paulski discloses receiving at least one digital image includes the step of receiving a plurality of digital images located on the physical medium [...user uploads digital images from removable memory card (330) to the network services provider; col. 11, lines 62-67; col. 12, lines 1-5; figures 6 and 7, step (117)]

and further comprising the step of receiving from the user a second input identifying at least one of the digital images to be embodied in the photofinishing product [...user can also select preferred colors, messages or images for the custom album cover; col. 8, lines 40-43].

Regarding **claim 9**, Parulski discloses the step of displaying the digital images prior to the step of receiving the second input from the user [...after the digital images are uploaded, the user can also select preferred colors, messages or images for the custom album cover; col. 8, lines 25-28; col. 40-43 and figure 2, step (118)].

Regarding **claim 10**, Parulski discloses the step of receiving an input from the user specifying at least one enhancement to the digital image [...customized graphics, text or image templates (col. 2, line 62); colors and logo; (col. 8, lines 40-43)].



Regarding **claim 11**, Parulski discloses said enhancement is selected from the group consisting of brightness, contrast and retouching [...customized graphics, text or image templates (col. 2, line 62); colors; (col. 8, lines 40-43)].

Regarding **claim 12**, Parulski discloses the step of receiving from the operator an input defining the predetermined quantities and the predetermined size of the package [...receiving the product information such as album the page size; col. 7, lines 57-66 and figure 5].

Regarding **claim 13**, Parulski discloses said input is received at least in part via a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 14**, Parulski discloses said input is received at least in part via a keyboard [...keyboard 16; figure 1A].

Regarding **claim 15**, Parulski discloses said input is received over a communications network [...network service provider 30; col.3, lines 56-59 and figure 1A-B].

Regarding **claim 16**, Parulski discloses said inputs are received at least in part via a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 17**, Parulski discloses said inputs are received at least in part via a keyboard [...keyboard 16; figure 1A].

Regarding **claim 18**, Parulski discloses inputs are received over a communications network [...network service provider 30; col.3, lines 56-59 and figure 1A-B].

Regarding **claim 19**, Parulski discloses wherein the offering step is performed via a graphical user interface displayed on a monitor [...a menu of customizable features of photo product is displayed on monitor 14 or touchscreen display 84 for customer select; col. 6, lines 39-39-43 and figure 1A].

Regarding **claim 20**, Parulski discloses the step of scanning at least one photographic image to produce said at least one digital image [...scanner 94; col. 4, lines 57-59 and figure 1A].

Regarding **claim 21**, Parulski discloses a digital photofinishing system, comprising:

- a digital image reader for receiving a physical medium on which at least one digital image is located [...card reader 96; col. lines 65-67 and figure 1A];

- a digital image processor for producing an output image from the digital image located on the physical medium [...CPU mother board 82; col. 4, lines 45-49 and figure 1A];

- an image output device for embodying the output image in an output medium [...color hardcopy printer 54; col. 5, lines 46-48 and figure 1B];

- a monitor for displaying the output image and offering to a user at least one operator-definable package of photofinishing products [...touchscreen display 84; col. 4, lines 53-54 and figure 1A];

- a controller operatively associated with the digital image reader, the digital image processor, the image output device and the monitor [...fulfillment center (40) communicates with home computer system (10) or retails kiosk 80 to perform the steps

of selecting, configuring, purchasing and shipping a photo product (60); see col. 3, lines 56-61; col. 5, lines 7-10; and figures 1A-1B];

an operator interface operatively associated with the controller for selectively defining at least one package of photofinishing products to be offered to the user [...touchscreen display (84) in retails kiosk (80) or home computers system (10) for user to selecting the type of photo product to purchase; figures 1A-B],

wherein the package of photofinishing products includes a second physical medium {{see figure 1B (photo product (66), custom album (62), frames (68), figure 2 (steps 118-124), figures 3-5; col. 8, lines 8, lines 40-67, col. 9, lines 6-11, discusses about the delivering the package of photofinishing products includes a second physical such as the custom album and framed print}. As for the further (potential) feature about the 2<sup>nd</sup> physical medium of "onto which the digital image is transferred", this is not positively recited and is interpreted as "being capable of". The physical medium of the reference is capable of this feature.

Regarding **claim 22**, Parulski discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities and at least one predetermined size [figures 3-4].

Regarding **claim 23**, Parulski discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities for each of a plurality of predetermined sizes [figures 3-4].

Regarding **claim 24**, Parulski discloses the package of photofinishing products further includes a price for said package [figure 2, step (106)].

Regarding **claim 27**, Parulski discloses said second physical medium is a CD-ROM [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding **claim 28**, Parulski discloses said image output device comprises a printer [...color hardcopy printer 54; col. 5, lines 46-48 and figure 1B].

Regarding **claim 29**, Parulski discloses a user interface for receiving an input from the user specifying at least one enhancement to the digital image [...a menu of customizable features of photo product is displayed on monitor 14 or touchscreen display 84 for customer select; col. 6, lines 39-39-43 and figure 1A].

Regarding **claim 30**, Parulski discloses said enhancement is selected from the group consisting of brightness, contrast and retouching [...customized graphics, text or image templates (col. 2, line 62); colors; (col. 8, lines 40-43)].

Regarding **claim 31**, Parulski discloses said operator interface further serves as a user interface for receiving an input from the user specifying at least one enhancement to the digital image [...customized graphics, text or image templates (col. 2, line 62); colors and logo; (col. 8, lines 40-43)].

Regarding **claim 32**, Parulski discloses said operator interface comprises a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 33**, Parulski discloses said operator interface comprises a keyboard [...keyboard 16; figure 1A].

Regarding **claim 34**, Parulski discloses said user interface and said operator interface comprise a common touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 35**, Parulski discloses said user interface and said operator interface comprise a common keyboard [...keyboard 16; figure 1A].

Regarding **claim 36**, Parulski discloses a scanner for scanning a photographic image to produce a digital image to be processed by the digital image processor [...scanner 94; col. 4, lines 57-59 and figure 1A].

### ***Response to Arguments***

8. Applicant's arguments filed 07/14/08 have been fully considered but they are not persuasive.

1. Applicant's comment that Parulski does not disclose "*providing a photofinishing product to the user in accordance with the specified package, wherein the package of photofinishing products includes a second physical medium onto which the digital image is transferred*". The Examiner respectfully disagrees. Parulski discloses providing a photofinishing product to the user in accordance with the specified package {see col. 9, lines 6-11; figure 2, steps (118-124), *photo product is delivered to the customer*}, wherein the package of photofinishing products includes a second physical medium {see figure 1B (photo product (66), custom album (62), frames (68), figure 2 (steps 118-124), figures 3-5; col. 8, lines 8, lines 40-67, col. 9, lines 6-11, discusses about the delivering the package of photofinishing products includes a second physical such as the custom album and framed print}. As for the reason stated above, Parulski discloses providing the photofinishing product to the customer in accordance with the specified package, and the package includes a physical medium.

Note: As for the further (potential) feature about the 2<sup>nd</sup> physical medium of “*onto which the digital image is transferred*”, this is not positively recited and is interpreted as “being capable of”. The physical medium of the reference is capable of this feature.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 3689

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689